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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GOTTSCHALK, MARTIN A

ART UNIT

PAPER NUMBER

3696

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/933,796	<b>Applicant(s)</b> BATTLE ET AL.	
	<b>Examiner</b> MARTIN A. GOTTSCHALK	<b>Art Unit</b> 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,7,10-12,18-28,30-33,37-39,42-44,46,47,49-51 and 53 is/are pending in the application.
- 4a) Of the above claim(s) 30 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,10-12,18-28,31-33,37-39,42-44,47,49-51 and 53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Notice to Applicant**

1. Claims 1, 2, 7, 10-12, 18-28, 30-33, 37-39, 42-44, 46, 47, 49-51, and 53 are pending. Claims 1, 2, 7, 10-12, 18-28, 31-33, 37-39, 42-44, 47, 49-51, and 53 have been examined. Claims 1, 18, 24, 31, 42, 43, and 47 are amended. Claims 30 and 46 have been withdrawn. Claims 3-6, 8, 9, 13-17, 29, 34-36, 40, 41, 45, 48, 52 and 54-61 are cancelled.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 7, 10-12, 18-28, 31-33, 37-39, 42-44, 47, 49-51, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillegass et al (PG Pub#: US 2002/0007351, hereinafter, Hillegass) in view of Davis et al (US 6105008, hereinafter Davis).

A. As per independent claims 1, 31, and 47 Hillegass discloses a method of providing tender from an issuer for a user transaction with a third party, comprising the steps of:

(a) an issuer receiving a request from the user for an electronic money instrument in a specified amount ([0028]; user reads on “token giver.” Note the various roles described as the “token distributor,” “token receiver” (or “token user”); and “token giver.” Note further that under certain circumstances, the token giver can also be the token receiver or user, [0029]);

(a1) the user paying said issuer a specified amount for said electronic money instrument (Hillegass: [0029]-[0030], i.e., Hillegass teaches the user pays the issuer with a credit card);

(b) the issuer issuing to the user a unique serial number to the user for said electronic money instrument, said electronic money instrument being a bearer instrument (Hillegass: [0030], “token ID” reads on serial number; [0042]. The token is a bearer instrument because whoever has it can use it to make a purchase.);

(c) the user retrievably storing said serial number (Hillegass: [0030], see below for the “transmitting feature of this step);

(e) the issuer accessing the stored serial number to determine if the electronic money instrument associated with the serial number is at least as large as the requested amount ([0032]);

(f) the issuer approving the request if the amount associated with the serial number is at least as large as the requested amount ([0032]);

(g) the issuer refusing the request if the amount associated with the serial number is less than the requested amount ([0033]);

and

(h) upon approval, the issuer retrievably storing additional item information associating the serial number with an indication that no further third party requests for funds can be approved ([0034]-[0035]; e.g. reads on "...date of the last transaction involving the token.").

Hillegass fails to teach the "transmitting" feature of step c, however, this feature is well known in the art as evidenced by the teachings of Davis who teaches a system and method that includes a user smart card which receives value loading from an "issuer" source (like a bank), transmits payment information from the user to a merchant, followed by a settlement request from the user, specifically

(c) transmitting <said serial number to> a third party in payment (Davis: col 11, Ins 17-25, i.e. "...processes the user order...").

Hillegass also fails to explicitly teach step d, which is also taught by Davis:

(d) the issuer receiving a request for funds from the third party, the request including the serial number and the amount requested (Suggested by Hillegass: Fig 2; [0032]; note the “redemption process,” where the third party is the receiver in the “gift certificate” scenario. Davis: col 11, lns 29-40 teaches a clearing system remitting payment to a merchant making a request after a credit sale to a user.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Davis into the system taught by Hillegass with the motivation of adding the functionality of a smart card to a computer-only system, and to further provide a method of conveniently loading value onto the card (Davis: col 3, lns 60-64).

C. As per claims 2, 32, 42, 49, and 51, Hillegass teaches the method of claim 1, wherein the step of retrievably storing item information includes storage in a remote hosting site serving more than one issuer (Hillegass: [0030]).

D. As per claims 7, 33, 37, 50, Hillegass teaches the method of claim 1, which further comprises the step, by the issuer, of reimbursing the user for the difference between the tender amount and the amount of the approved third party request for

funds (Hillegass: [0032]-[0033], [0037]).

E. As per claims 10 and 38, Hillegass teaches the method of claim 1, wherein the step of receiving a request for a tender from a user further comprises: receiving the request at a site that is remote from the issuer; and forwarding the request from the remote site for receipt by the issuer (Hillegass: [0028]-[0032]).

F. As per claims 11 and 39, Hillegass teaches the method of claim 10, wherein the site is a retail outlet selling the tender item (Hillegass: [0011], [0046], [0050]).

G. As per claim 12, Hillegass teaches the method of claim 10, wherein the step of issuing to the user an item having a unique serial number further comprises issuing the item for receipt by the user at the remote site (Hillegass: [0029]).

H. As per claim 18, Hillegass teaches the method of claim 1, wherein the issued item also includes issuer contact information (Hillegass: [0030]).

I. As per claim 19, Hillegass teaches the method of claim 1, wherein the third party is the vendor (Hillegass: [0044]).

J. As per claim 20, Hillegass teaches the method of claim 1, wherein the third party is selling goods in the transaction (Hillegass: [0032]).

K. As per claim 21, Hillegass teaches the method of claim 1, wherein the third party is selling services in the transaction (Hillegass: [0032]).

L. As per claim 22, Hillegass teaches the method of claim 1, wherein the third party is accepting contributions in the transaction (Hillegass: [0032, i.e. a service]).

M. As per claim 23, Hillegass teaches the method of claim 1, wherein the third party is accepting payments for previously owed sums in the transaction (Hillegass: [0032, i.e. a service]).

O. As per claims 24, 42, 43, and 44, Hillegass teaches the method of claim 1, which further comprises a method for the third party to allow the user to use the issued tender item as tender for an online transaction with the third party, the method comprising the steps, by the third party, of: providing a user-accessible online transaction site; receiving the user's inputted selection of subject matter to be included in the transaction; determining the amount of tender required to consummate the transaction based on the user's inputted selection of subject matter, and communicating the amount to the user; receiving the user's selection of the issued tender item as the type of tender to be used to consummate the transaction; receiving the tender item identification information upon entry by the user; choosing between acceptance or rejection of the tender item, and communicating the choice to the user (Hillegass: [0044]).



P. As per claim 25, Hillegass teaches the method of claim 24, wherein the subject matter includes goods (Hillegass: [0032]).

Q. As per claim 26, Hillegass teaches the method of claim 24, wherein the subject matter includes services (Hillegass: [0032]).

R. As per claim 27, Hillegass teaches the method of claim 24, wherein the subject matter includes donations to the third party (Hillegass: [0032, i.e. a service]).

S. As per claim 28, Hillegass teaches the method of claim 24, wherein the subject matter includes payment of sums previously owed to the third party (Hillegass: [0032, i.e. a service]).

### ***Response to Arguments***

Applicant's arguments have been considered but are not persuasive. The arguments pertain to amendments made to the claims, and either explanations are provided above for the amended feature (i.e. bearer instrument), or the arguments are moot in view of new grounds of rejection.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art (Walker: [US Pat# 6,193,155]) teaches methods for the on-line management of gift certificates.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARTIN A. GOTTSCHALK whose telephone number is (571)272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3696

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Martin A. Gottschalk/  
Examiner, Art Unit 3696

/Ella Colbert/  
Primary Examiner, Art Unit 3696